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PATENT

Attorney Docket No.: 017887-000310US

Mail Stop Appeal Brief - Patent

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

On April 20, 2004

TOWNSEND and TOWNSEND and CREW LLP

By: Julie Taylor Clough

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APR 28 2004

Technology Center 2100

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of:

Farzad Nazem

Application No.: 09/393,718

Filed: September 10, 1999

For: Dynamic Page Generator

Examiner: Cindy Nguyen

Art Unit: 3195

**APPELLANT'S BRIEF UNDER 37 CFR
§1.192**

Mail Stop Appeal Brief - Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Appellant hereby submits this Appellant Brief in triplicate pursuant to 37 CFR §1.192(a). Appellant authorizes the Commissioner to deduct the requisite fee of \$330.00 pursuant to 37 CFR §1.17(c) from Deposit Account No. 20-1430 and any additional fees associated with this Brief.

04/26/2004 EFLORES 00000051 201430 09393718

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I. REAL PARTY IN INTEREST

The real party in interest of the subject patent application is Yahoo!, Inc., the assignee of the present application.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals and interferences known to Appellant, Appellant's legal representative, or assignee that will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending Appeal.

III. STATUS OF CLAIMS

Claims 10-28 are pending. Claims 10-28 stand finally rejected. Appellant appeals from the rejection of all of these claims.

IV. STATUS OF AMENDMENTS

No amendment was filed subsequent to the final rejection.

V. SUMMARY OF THE INVENTION:

The present invention generally relates to the field of customized information presentation and more specifically to a custom page server configured to serve a customized page according to a user's preferences.

Embodiments of the present invention are directed towards an improved custom page server. User preferences are organized into templates that are stored and live data is obtained from information sources and used to fill a user template. *See specification, page 2, lines 24-29.* The user template program is stored in a data structure that is indexed by a user identifier that is unique to a user. *See specification, page 5, lines 14-26.* Upon receiving a user request for a customized page, a user identifier is determined. *See specification, page 4, lines 31-37.* A stored template program specific to a user is then retrieved using the user identifier. *See specification, page 5, lines 1-26.*

The template program is executed to generate a customized page for the user. The customized page includes real-time information that is used as input to the template program to generate the customized page. *See specification*, page 6, lines 1-9. The user is then provided with a customized page where the customized page includes at least one item of real-time information selected from the storage device. *See specification*, page 9, lines 10-24.

VI. ISSUE PRESENTED

The issue on appeal is:

Are claims 10-14, 19 and 20 unpatentable under 35 U.S.C. § 103(a) over Butman, et. al (U.S. Patent No. 5,867,665, hereinafter "Butman") in view of DuFresne (U.S. Patent No. 5,35,712), and are claims 15-18 and 21-28 unpatentable under 35 U.S.C. § 103(a) over Butman in view of DuFresne and further in view of Gerace (U.S. Patent No. 5,848,396)?

VII. GROUPING OF THE CLAIMS:

The claims do not stand or fall together. While each claim might stand alone for patentability purposes, for expediency, Appellant has grouped claims into three groups of claims to be given separate consideration for purposes of this appeal. The first group of claims (the "Group I claims") includes independent claim 10 and dependent claims 11-18; the second group of claims (the "Group II claims") includes independent claim 19; and the third group of claims (the "Group III claims") includes independent claim 20 and dependent claims 21-28. Appellant could argue for separate patentability of a number of dependent claims, but because Appellant believes the independent claims are allowable and the dependent claims derive patentability at least in part from the independent claims, Appellant focuses this appeal on the three groups of claims stated above without conceding separate patentability of the dependent claims.

VIII. ARGUMENT

A. The Group I claims

1. Overview of the Section 103(a) Argument

Butman and DuFresne, either alone or in combination, do not teach or suggest: storing a user-specific template program for the user in a data structure indexed by a user identifier unique to the user;

... determining a user identifier associated with the request; retrieving a stored template program specific to the user in the data structure using the determined user identifier associated with the request; executing the template program specific to the user using the real-time information stored in the storage device as input to the template program to generate the customized page, wherein the template program indicates items of interest to the user; and providing the user with the customized page, wherein the customized page includes at least one item of real-time information selected from the storage device.

Appellant respectfully submits that the Section 103 rejection is improper because every element is not taught or suggested by Butman and DuFresne, either alone or in combination. To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to meet the claimed combination and the reasonable expectation of success must both be found in the prior art reference, and not be based on the applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d. 1438 (Fed. Cir. 1991). (See MPEP § 2143).

2. Overview Of The Cited References

Butman discloses a domain communication server for storing a dynamic client registry for client side communication servers. The domain communication server determines all domain clients that may be within a domain. *See Butman*, col. 27, lines 45-52. The domain's content is loaded from table indexes and stored internally as index objects. *See Butman*, col. 27, lines 41-44. The domain communication server determines templates that are used by the domain's clients. The templates are used to organize the domain's index objects. *See Butman*, col. 27, lines 53-62.

DuFresne discloses systems and methods for providing templates for constructing web source text. DuFresne states that access control lists are used to limit access to a specific group of authorized users. *See DuFresne*, col. 10, lines 9-11.

3. Prosecution History

In an Office Action mailed November 20, 2003, the Examiner rejected claim 10 over Butman and DuFresne. The Examiner stated that Butman disclosed every element of claim 10 but did not disclose "executing the template program specific to the user using the real-time information stored in the storage device as input to the template program to generate the customized page, wherein the template program indicates items of interest to the user." The Examiner cited DuFresne as disclosing this element. Also, the Examiner stated that "it would have been obvious to a person of ordinary skill in the art to include the steps to input data in realtime to the template to generate the customized page as claimed in the system of Butman as taught by DuFresne. The motivation being enable the input interesting data in which authorized user can input HTML source and codes and then store the information on template to a database so that authorized clients and server can access to the template (col. 10, lines 18-41, DuFresne)."

In a response mailed January 22, 2004, Appellant respectfully traversed the rejection. Appellant stated that Butman does not disclose or suggest user-specific templates. Also, Appellant stated that Butman does not disclose or suggest that user specific templates are indexed by a user identifier unique to a user and that a stored template program specific to the user is retrieved using a determined user identifier. Additionally, Appellant argued that DuFresne's access control lists do not disclose or suggest template programs specific to a user where a template program indicates items of interest to the user.

In an advisory action mailed February 10, 2004, the Examiner stated that the response of the Appellant did not place the application in condition for an allowance because Appellant's arguments were not persuasive. In the advisory action, the Examiner stated that Appellant is reminded that he is responsible for the four corners of the references. In particular, it was stated that DuFresne as applied teaches the use of user specific templates. The Examiner did not specifically address the arguments with respect to Butman.

4. Butman and DuFresne, either alone or in combination, do not disclose or suggest every element of the Group I Claims

Appellant submits that Butman and DuFresne, either alone or in combination do not disclose or suggest every element of claim 10 and further that the Examiner has not

substantively responded to the Appellant's arguments. The Final Rejection states that Butman discloses displaying a user-specific template program for a user in a data structure indexed by a user identifier unique to the user at col. 27, lines 40-62. The passage cited in Butman discloses predefined templates for use by the domain's clients. Appellant submits that the predefined templates do not disclose or suggest user-specific templates. Rather, Butman states that multiple clients use the predefined templates. *See Butman*, col. 27, lines 53-56. Accordingly, Butman does not disclose or suggest user-specific templates.

Further, the cited section discloses that templates are used to organize the domain's index objects. The index objects are used to organize content by subject matter within a given domain. *See Butman*, col. 30, lines 2-6. This does not disclose or suggest a user-specific template program that is used to generate a page. Rather, the index objects are a list of subjects that are used by a domain communications server to retrieve content from other servers. The list of subjects is not specific to a user and cannot be used to generate a customized page for a user. Moreover, Butman discloses that objects are shared with any number of client side communication servers. *See Butman*, col. 21, lines 41-44. Accordingly, not only do clients in a domain use the templates, multiple client side communication servers may access the templates. Each client side communication server may be associated with a domain and include a number of clients. Thus, within a domain, multiple clients may be associated with the templates and multiple client side communication servers (each of which may have multiple domain clients) are associated with the templates. Accordingly, Butman contemplates that multiple client side communication servers and domain clients in the domains associated with the client side communication servers can access the templates. Thus, Butman does not disclose or suggest that the objects are indexed by a user identifier that is unique to the user or that they are user-specific.

Further, there is no suggestion in Butman that the templates are user-specific or that the templates would be indexed by a user identifier. Even if DuFresne disclosed user-specific templates (it does not), it would not have been obvious to include user-specific templates in Butman because the templates in Butman are meant to be used for multiple client side communication servers and their domain clients. The templates are used to organize a domain's index objects. The index objects table is used to determine which client side communication servers are authorized to receive an object. If multiple client side communication servers are

associated with an object, they would be listed in the table as having access to the object. Butman does not contemplate that each client side communication server includes a separate template. Moreover, the objects table does not disclose or suggest a template that is used to generate a customized page. Rather, it is used to determine which data should be sent to which client side communication servers.

The final rejection further asserts that retrieving a stored template program specific to the user in the data structure using the determined user identifier associated with the request is disclosed at col. 30, lines 24-36 in Butman. This passage discloses virtual server objects are returned to a client. Appellant submits that the cited section does not disclose or suggest a stored template program that is specific to a user and that is retrieved using a determined user identifier. Rather, the objects referenced are used to determine the sites of all other client side communication servers considered to be of the same firm. This does not suggest retrieving a stored template program specific to a user.

Additionally, the rejection asserts that Butman does not disclose or suggest executing a template program specific to the user using real time information stored in the source device's input to the template program to generate the customized page, wherein the template program indicates items of interest to the user, but DuFresne does. In the response to the final rejection, Appellant's traversed this point and specifically argued that DuFresne does not disclose or suggest a template program specific to a user. In the Advisory Action, the Examiner stated that DuFresne is applied as teaching the user-specific templates and that Appellant was reminded that he is responsible for the four corners of the references.

DuFresne discloses access control lists that limit access to a specific group of authorized users. Appellant submits that this does not disclose or suggest a template program specific to a user where the template program includes items of interest to the user. DuFresne discloses that access control lists limit access to a group of authorized users. *See DuFresne*, col. 10, lines 9-11. Appellant submits that controlling access for a group of authorized users does not disclose or suggest user-specific templates. Also, DuFresne is directed towards controlling access to templates. Even if access is limited to a single user, this only suggests that a single user can access the template. Nowhere in DuFresne is it disclosed or suggested that the templates are user specific. Access to a single user may only be inferred but whether the

templates are user-specific is not disclosed or suggested by DuFresne. For example, the templates may be used for multiple users but only a single user may access a template. The access control list is for allowing only certain users to edit the template. Moreover, DuFresne does not disclose or suggest that a user-specific template program indicates items of interest to a user.

DuFresne also does not cure the defects of the Butman reference. For example, DuFresne and Butman, either alone or in combination, do not disclose or suggest that templates are indexed by a user identifier unique to a user or user-specific templates. Thus, Butman and DuFresne, either alone or in combination, do not disclose or suggest every element of claim 10.

B. The Group II claims

1. Prosecution History

The Group II claims were rejected for the same reasons as were stated for the Group I claims in the Final Office Action mailed November 20, 2003. Appellant argued in response to the Final Office Action that claim 19 should be allowable for at least a similar rationale discussed with respect to claim 10. In an Advisory Action mailed February 10, 2004, the Examiner stated the Appellant's arguments are not persuasive. Appellant was reminded that he is responsible for the four corners of the references. In particular, DuFresne is applied as teaching the use of user-specific templates (last paragraph, page 3 of the previous action).

2. Butman and DuFresne, either alone or in combination, do not disclose or suggest every element of the Group II claims

Appellant submits that Butman and DuFresne, either alone or in combination, do not disclose or suggest "storing user-specific template programs for each of a plurality of users in a data structure indexed by user identifiers." Additionally, Butman and DuFresne, either alone or in combination, do not disclose or suggest for each of a plurality of users, forming a template program for a specific user. Further, Butman and DuFresne, either alone or in combination, do not disclose or suggest retrieving a stored template program specific to a user using a determined user identifier for the user, executing the template program specific to the user or providing the

user with a customized page. Accordingly, Appellant submits that Butman and DuFresne, either alone or in combination, do not disclose or suggest every element of the Group II claims.

C. The Group III claims

1. Prosecution History

The Group III claims rejected for the same reasons as the Group I and Group II claims in the Final Office Action mailed November 20, 2003 in addition, the Office Action stated that Butman/DuFresne disclosed "a second template program specific to the second user (col. 9, lines 50-59, DuFresne) using the real time information stored in the storage device as input to the second template program to generate a second customized page for a second user (col. 10, lines 7-32, DuFresne)." In response to the Final Office Action, Appellant argued that claim 20 should be allowable for at least a similar rationale as discussed with respect to claim 10. Additionally, Appellant argued, in the response mailed January 22, 2004, that DuFresne and Butman, either alone or in combination, do not disclose or suggest generating a first customized page for a first user and a second customized page for a second user.

2. Butman and DuFresne, either alone or in combination, do not disclose or suggest every element of the Group III claims.

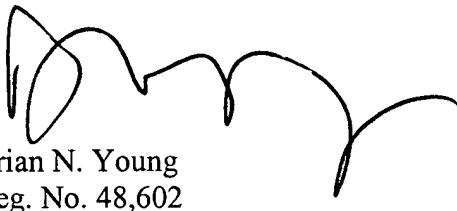
Appellant submits that claim 20 should be allowable for at least a similar rationale as discussed with respect to the Group I and Group II claims. Additionally, Appellant submits that DuFresne and Butman, either alone or in combination, do not disclose or suggest a first stored template program specific to a first user and a second stored template program specific to a second user. Also, DuFresne and Butman, either alone or in combination, do not disclose or suggest generating a first customized page for the first user and a second customized page for the second user. The rejection cited col. 19, lines 50-59 as describing this element. This passage in DuFresne discloses templates that include ID fields or access control fields. The access control fields and ID may limit access and provide an ID for a template but do not disclose or suggest a first template program for a first user and a second template program for a second user, or a first customized page for the first user and a second customized page for the second user. In fact, DuFresne and Butman, either alone or in combination, do not disclose or suggest user-specific

Farzad Nazem
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Page 10

templates. Accordingly, Butman and DuFresne, either alone or in combination, do not disclose or suggest every element of the Group III claims.

Please deduct the requisite fee, pursuant to 37 CFR § 1.17(c), of \$330.00 from deposit account 20-1430 and any additional fees associated with this Brief. This Brief is submitted in triplicate.

Respectfully submitted,


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O.I.P.E. JC3-1

FEE TRANSMITTAL for FY 2004

Effective 10/01/2003. Patent fees are subject to annual revision.

 Applicant claims small entity status. See 37 CFR 1.27

TOTAL AMOUNT OF PAYMENT (\$ 330

Complete if Known

Application Number	09/393,718
Filing Date	September 10, 1999
First Named Inventor	Farzad Nazem
Examiner Name	Nguyen, Cindy
Art Unit	2756
Attorney Docket No.	017887-000310US Technology Center 2100

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METHOD OF PAYMENT (check all that apply)

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Deposit Account Number

20-1430

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The Director is authorized to: (check all that apply)

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 Charge any additional fee(s) or any underpayment of fee(s)
 Charge fee(s) indicated below, except for the filing fee to the above-identified deposit account.

FEE CALCULATION

1. BASIC FILING FEE

Large Entity	Small Entity	Fee Code (\$)	Fee Code (\$)	Fee Description	Fee Paid
1001 770	2001 385	Utility filing fee			
1002 340	2002 170	Design filing fee			
1003 530	2003 265	Plant filing fee			
1004 770	2004 385	Reissue filing fee			
1005 160	2005 80	Provisional filing fee			

SUBTOTAL (1) (\$)

2. EXTRA CLAIM FEES FOR UTILITY AND REISSUE

Total Claims	Independent Claims	Multiple Dependent	Extra Claims	Fee from below	Fee Paid

Large Entity Small Entity

Fee Code (\$)	Fee Code (\$)	Fee Description
1202 18	2202 9	Claims in excess of 20
1201 86	2201 43	Independent claims in excess of 3
1203 290	2203 145	Multiple dependent claim, if not paid
1204 86	2204 43	** Reissue independent claims over original patent
1205 18	2205 9	** Reissue claims in excess of 20 and over original patent

SUBTOTAL (2) (\$)

** or number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)

3. ADDITIONAL FEES

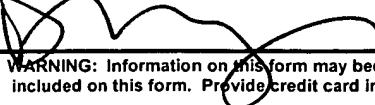
Large Entity	Entity	Small Entity	Entity	Fee Description	Fee Paid
Fee Code	Fee (\$)	Fee Code	Fee (\$)		
1051	130	2051	65	Surcharge - late filing fee or oath	
1052	50	2052	25	Surcharge - late provisional filing fee or cover sheet	
1053	130	1053	130	Non-English specification	
1812	2,520	1812	2,520	For filing a request for reexamination	
1804	920*	1804	920*	Requesting publication of SIR prior to Examiner action	
1805	1,840*	1805	1,840*	Requesting publication of SIR after Examiner action	
1251	110	2251	55	Extension for reply within first month	
1252	420	2252	210	Extension for reply within second month	
1253	950	2253	475	Extension for reply within third month	
1254	1,480	2254	740	Extension for reply within fourth month	
1255	2,010	2255	1,005	Extension for reply within fifth month	
1401	330	2401	165	Notice of Appeal	
1402	330	2402	165	Filing a brief in support of an appeal	330
1403	290	2403	145	Request for oral hearing	
1451	1,510	1451	1,510	Petition to institute a public use proceeding	
1452	110	2452	55	Petition to revive - unavoidable	
1453	1,330	2453	665	Petition to revive - unintentional	
1501	1,330	2501	665	Utility issue fee (or reissue)	
1502	480	2502	240	Design issue fee	
1503	640	2503	320	Plant issue fee	
1460	130	1460	130	Petitions to the Commissioner	
1807	50	1807	50	Petitions related to provisional applications	
1806	180	1806	180	Submission of Information Disclosure Stmt	
8021	40	8021	40	Recording each patent assignment per property (times number of properties)	
1809	770	2809	385	Filing a submission after final rejection (37 CFR § 1.129(a))	
1810	770	2810	385	For each additional invention to be examined (37 CFR § 1.129(b))	
1801	770	2801	385	Request for Continued Examination (RCE)	
1802	900	1802	900	Request for expedited examination of a design application	

Other fee (specify) _____

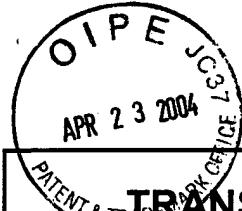
*Reduced by Basic Filing Fee Paid SUBTOTAL (3) (\$330)

SUBMITTED BY

Complete (if applicable)

Name (Print/Type)	Brian N. Young	Registration No. (Attorney/Agent)	48,602	Telephone	415-576-0200
Signature				Date	4/20/04

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AF 27566-300
PTO/SB/21 (08-03)

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/393,718
		Filing Date	September 10, 1999
		First Named Inventor	Farzad Nazem
		Art Unit	2756
		Examiner Name	Nguyen, Cindy
Total Number of Pages in This Submission	12	Attorney Docket Number	017887-000310US

ENCLOSURES (Check all that apply)					
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s)	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) <small>(please identify below):</small> Return Postcard			
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		The Commissioner is authorized to charge any additional fees to Deposit Account 20-1430.			

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm or Individual	Townsend and Townsend and Crew LLP Brian N. Young	
Signature		
Date	4/16/04	

CERTIFICATE OF TRANSMISSION/MAILING			
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Signature		Date	April 20, 2004